

REMARKS/ARGUMENTS

In response to the Office action dated April 22, 2003, the Applicants have responded to the Examiner's rejection of the claims below. Claims 7 and 37 have been canceled. Claims 1, 8-12, 15-17, 19, 23, 25, 32, 33, 35, 36, and 38-47 has been amended. Claims 49-91 have been added. Claims 1, 8-12, 15-17, 19, 23, 25, 32-36, and 38-91 are pending in the application.

Applicants hereby request further examination and reconsideration of the application in view of the foregoing amendments and the following remarks.

In Paragraph 3 of the Office action, the Examiner objected to Claim 17 because of informalities in the claim. Applicants have amended claim 17 to change the word "active" to "activate" to overcome the Examiner's objection.

In Paragraph 5 of the Office action, the Examiner rejected claims 1, 7-12, 15-16, 32-41 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Raith (US 6,493,550). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for each of the claims for the grounds provided below and that the Examiner's rejection should be withdrawn. See M.P.E.P. § 2142 (8th ed. 2001).

A *prima facie* case of obviousness may be established by combining two or more references where there is a suggestion, teaching or motivation in the references themselves or in the knowledge generally available to a person having ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); *In re Nilssen*, 851 F.2d 1401, 7 U.S.P.Q.2d 1500 (Fed. Cir. 1988). Both the teaching and a reasonable expectation of success must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed.Cir. 1991). Where no expressed teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984).

The Examiner has rejected the claims 1, 7-12, 15-16, 32-41 without providing references that teach the elements in the respective claims and justifying the rejection with statements that "it is well-known and conventional in the art to . . ." It is actually accepted and well-known that the Examiner in all obviousness rejections is required to show some motivation for combining teachings in the prior art and not simply provide rote statements that claimed elements are well known and conventional in the art. See *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). It is also accepted and well known that most inventions are combinations of old and known element. See *id.* However, the court in *In re Rouffet* specifically states that:

To prevent the use of hindsight based on the invention to defeat patentability, **this court requires** the examiner to show a motivation to combine the references that create the case of obviousness. In other words, **the examiner must** show reasons that the skilled artisan, confronted with the same problems as in the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

47 U.S.P.Q.2d at 1457-1458 (emphasis added). It is clear that the Examiner is required to provide motivation for all suggested combinations.

Grube discloses a communication system where a communication can be switched from a system mode of operation to a direct mode of operation between two communication units when the distance relationship between the units involved in the communication is obtained, at Abstract. A communication resource controller determines the geographic separation of the units, at column 2, lines 53-67. When the distance relationship between the units is relatively small, the communication resource controller transmits a mode change message to the units to switch operating modes from one of a system communication resource to one of a direct mode resource, at column 2, lines 20-26. Raith concerns the use of "proximity detectors which recognize proximity signals transmitted by a proximity system," at Abstract. This provides "a mechanism which is independent of public radiocommunications cell characteristics for recognizing the presence of a private radiocommunication system," at Abstract. "The proximity system can emit a signal with or without data modulation thereon for detection by the mobile station," at Abstract. The recognition of the proximity signals transmitted by the proximity detectors "triggers a search, for example, for a private radiocommunication control channel," at Abstract.

Grube discloses an invention to encourage direct communication between mobile units in order to conserve the communications network's system resources for wide range communications, at column 2, line 23-30. Raith provides "a proximity system and a proximity detector within the mobile station which provides the mobile station with a triggering mechanism for locating a private radiocommunication system's control channel," at column 4, lines 57-61. The invention disclosed by Grube seeks to avoid using the system resources of a communications network. The invention disclosed in Raith seeks to "interact with both public and private radiocommunication systems," at column 1, lines 7-9. The Examiner has provided no reason that a skilled artisan, when confronted with the same problems as the Applicants, would select the elements from Grube and Raith for combination in the manner claimed by Applicants. The Examiner has shown no suggestion, teaching or motivation in the references themselves or in the knowledge generally available to a person having ordinary skill in the art that would lead a skilled artisan to combine the references in the manner claimed by Applicants. As stated previously, there must also be a reasonable expectation of success. Simply because a modification may be able to be done does not mean that a modification would have been done. The Examiner cannot rely on hindsight to defeat patentability.

The modifications suggested by the Examiner on page 4, lines 4-20, are not supported by the references. The Bluetooth communications referred to by the Examiner in Raith concern communications between a mobile station and the proximity system, at column 6, lines 5-6. The proximity detectors in Raith are used to “recognize the proximity signals transmitted by a proximity system,” at Abstract. The Examiner discusses the use of handsets engaged in short-range communications with other handsets, page 4, line 11, the use of handsets directly to another handset, page 4, line 15, and permitting the generation of control signals from one mobile radio terminal to other mobile terminals, page 4, line 20 to page 5, line 1; however, these types of direct handset communications are not supported by the disclosure in Raith. Applicants can find nowhere in Raith where it discusses direct communications between mobile stations. Applicants can also find nowhere in Raith where the proximity detectors are used apart from the use of a proximity system. Incorporating a proximity detector into a SIM as suggested by the Examiner does not provide for direct communications between the mobile stations, nor does it explain how a proximity detector will work apart from a proximity system. The prior art does not teach the modifications proposed by the Examiner and there can be no reasonable expectation of success. Applicants respectfully submit that the Examiner’s modifications are not supported by the references and that there would be no motivation to modify the references as proposed.

As the Examiner has failed to provide any motivation for the proposed combinations, a *prima facie* case of obviousness has not been established with respect to claims 1, 7-12, 15-16, 32-41.

When evaluating a claim for determining obviousness, each limitation of the rejected claim must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

With regard to claim 1, Grube and Raith do not teach or suggest “generating a control signal in response to comparing the locations of the first mobile radio terminal and the second mobile radio terminal, wherein the control signal activates the first mobile radio terminal if the locations of the first mobile radio terminal and the second mobile radio terminal are within a specified distance.” With regard to claim 17, Grube and Raith do not teach or suggest “generating a control signal based upon comparing the locations of the first and second mobile radio terminals and transmitting the control signal to the first mobile radio terminal to activate the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are within a specified distance.” With regard to claim 23, Grube and Raith do not teach or suggest “generating a control signal based upon comparing the received locations of the first and second mobile radio terminals and transmitting the control signal to the first mobile radio terminal to activate the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are within a specified distance.” Grube and Raith do not teach or suggest the activation of a first mobile radio terminal. The communication units in Grube are already active because they are engaged or about to be engaged in a communication when the units receive a mode change message, at column 2, lines 16-29. In Grube, a change mode message

merely instructs the communications units to change from one mode of operation to another; it does not activate or deactivate the communication units. For these reasons, a *prima facie* case of obviousness cannot be established.

With regard to claim 11, Grube and Raith do not teach or suggest “comparing at least one of: the specific location of the at least two mobile radio terminals to at least one predetermined location, and the specific location of the at least two mobile radio terminals and time to at least one predetermined location and time.” Applicants can find no reference in Grube that teaches or suggests the use of predetermined locations or times. The predetermined threshold disclosed in Grube is a distance parameter, at column 3, lines 20-23, Figs. 2 and 3. Applicants respectfully submit that while the Examiner asserts that Grube could use a predetermined location and preselect time, the Examiner’s assertion is not supported or suggested by the disclosure in Grube. The only predetermined threshold disclosed in Grube is a distance parameter. No other types of thresholds are taught or suggested by Grube. For these reasons, a *prima facie* case of obviousness cannot be established.

For all of the above reasons, Grube and Raith, taken singly or in combination, fail to teach or suggest all of the subject matter of claims 1, 11, 17, and 23 as required by 35 U.S.C. §103(a).

If a prior art reference is cited that requires some modification in order to be properly combined with another reference and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed invention. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). When a §103 rejection is based upon the modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made. *See id.*

Grube discloses a communication system wherein a communication can be switched from a system mode of operation to a direct mode of operation between two communications units when the distance relationship between the units involved in the communication is obtained, at Abstract. A communication resource controller determines the geographic separation of the units, at column 2, lines 53-67. When the desired distance relationship is met, the communication resource controller transmits a mode change message to the units to switch communication modes, at column 2, lines 20-23. Raith concerns the use of “proximity detectors which recognize proximity signals transmitted by a proximity system,” at Abstract. “The proximity system can be integrated into the private radio communication system or can be a standalone system that is connected to the private radiocommunication system,” at column 3, lines 9-12. This provides “a mechanism which is independent of public radiocommunications cell characteristics for recognizing the presence of a private radiocommunication system,” at Abstract. “The proximity system can emit a signal with or without data modulation thereon for detection by the mobile station,” at Abstract. The proximity system and proximity detector

provide "the mobile station with a triggering mechanism for locating a private radiocommunication system's control channel," at column 4, lines 58-61. The intended purpose and function of the invention disclosed in Grube is to minimize the use of system resources by allowing two mobile units to communicate directly with each other when they are within a certain distance. Raith teaches away from the purpose disclosed in Grube. Raith does not teach the minimization of system resources, but rather the use of another system's resources. In so doing, Raith destroys the purpose disclosed in Grube of facilitating direct communications between mobile units in order to minimize the use of system resources. Such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made.

In Paragraph 6 of the Office action, the Examiner rejected claims 17, 19, 23, 25 and 42-48 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Lachance (US 6,246,882) and Raith (US 6,493,550). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for each of the claims for the grounds provided below and that the Examiner's rejection should be withdrawn. See M.P.E.P. § 2142 (8th ed. 2001). Further, Lachance does not make up for the deficiencies of the Grube and Raith references such that claims 17, 19, 23, 25 and 42-48 are allowed over the cited prior art.

For the reasons discussed above, the Examiner has failed to establish a *prima facie* case of obviousness concerning the invention claimed by the Applicants based on the Grube and Raith references. As stated previously, a *prima facie* case of obviousness may be established by combining two or more references where there is a suggestion, teaching or motivation in the references themselves or in the knowledge generally available to a person having ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); *In re Nilssen*, 851 F.2d 1401, 7 U.S.P.Q.2d 1500 (Fed. Cir. 1988). Both the teaching and a reasonable expectation of success must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed.Cir. 1991). Where no expressed teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984).

With regard to the addition of the Lachance reference, there is no motivation to combine or modify the Grobe and Lachance references. Lachance discloses a wide area item tracking system and method wherein "[e]ach item to be tracked in the system has associated therewith an item identifier," at column 1, lines 52-58. "When the item is moved past a handling zone interrogator into a new handling zone, an item identification reader detects the item identifier," at column 1, lines 61-63. "A mobile station connected to the item identification reader transmits a signal containing the item identifier and an identification of the handling zone over an air interface of a cellular network," at column 1, lines 63-67. Applicants can find no reference in Lachance to direct communications between mobile units. In fact, Lachance specifically states that a cellular network is used to facilitate the transmission of data, at column 1, line 63-67. The

Examiner has provided no reason that a skilled artisan, when confronted with the same problems as the Applicants, would select the elements from Grube and Lachance for combination in the manner claimed by Applicants. The Examiner has shown no suggestion, teaching or motivation in the references themselves or in the knowledge generally available to a person having ordinary skill in the art that would lead a skilled artisan to combine the references in the manner claimed by Applicants. As stated previously, there must also be a reasonable expectation of success. Simply because a modification may be able to be done does not mean that a modification would have been done. The Examiner cannot rely on hindsight to defeat patentability. For all of the above reasons, Grube, Lachance and Raith, taken singly or in combination, fail to teach or suggest all of the subject matter of claims 17, 19, 23, 25 and 42-48 as required by 35 U.S.C. §103(a).

The Commissioner is hereby authorized to charge payment of any additional filing or application fees associated with this communication or credit any overpayment to Deposit Account No. 13-4365.

For the foregoing reasons, the Applicants respectfully submit that claims 1, 8-12, 15-17, 19, 23, 25, 32-36, and 38-91 are now in condition for allowance. Reconsideration and withdrawal of the rejection is requested. Allowance of claims 1, 8-12, 15-17, 19, 23, 25, 32-36, and 38-91 at an early date is respectfully requested.

If the Examiner has any questions about the present Amendment or anticipates finally rejecting any claim of the present application, a telephone interview is requested.

Respectfully submitted,



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